

REMARKS

The Final Office Action dated August 29, 2001 and the references cited therein have been carefully considered. In response to the Office Action, Applicant has amended Claims 3, 9 and 17 which, when considered with the remarks set forth below, are deemed to place the case in condition for allowance. As a result of the present Amendment, Claims 1-10 and 17 remain in the case for continued prosecution. Applicant respectfully requests withdrawal of the Final Office Action.

In the Office Action, Claim 9 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner states that the language of Claim 9 is confusing in that Claim 1 defines a housing as a monolithic structure, while Claim 9 defines a housing having two parts that are sealed together by ultrasonic welding. In response, Applicant has amended Claims 3 and 9 to define a thermometer including a monolithic housing and a cover part secured to the housing by ultrasonic welding. Accordingly, it is respectfully submitted that the 35 U.S.C. §112, second paragraph, rejection has been overcome.

The Examiner has also rejected Claims 1-3, 6, 10 and 17 under 35 U.S.C. §103(a) as being unpatentable over JP 07027626 (hereinafter JP) in view of U.S. Patent No. 4,037,470 to Mock, et al., (hereinafter Mock) and has rejected Claims 4, 5 and 7-9 under 35 U.S.C. §103(a) as being unpatentable over JP and Mock, and further in view of U.S. Patent No. 4,729,672 to Takagi (hereinafter Takagi), U.S. Patent No. 4,738,549 to Plimpton (hereinafter Plimpton) and U.S. Patent No. 6,068,399 to Tseng, et al. (hereinafter Tseng). Specifically, the Examiner indicates that the JP reference discloses a thermometer comprising a monolithic housing made of a transparent material, wherein the housing, other than the viewing area is coated with an opaque coating. The Examiner notes that the Japanese reference does not disclose an inner or outer surface of the housing made opaque by roughening. However, the

Examiner cites Mock as disclosing an inner spherical surface roughened in order to increase its absorptivity (decreased transparency, to make light diffusely scattered). Therefore, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the thermometer disclosed by the Japanese reference to have an inner or outer surface roughened in order to increase its absorptivity as taught by Mock.

With respect to Claims 4, 5 and 7-9, the Examiner further states that the limitations found in these Claims, that are not disclosed by the JP and/or Mock references are found in one or more of the additionally cited references. Therefore, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the JP and Mock references with the teachings of one or more of the additionally cited references to obtain a device as defined by Claims 4, 5 and 7-9.

In response to the Office Action, Applicant has amended independent Claim 17 and respectfully traverses the §103(a) claim rejection with respect to independent Claim 1. In particular, Applicant sets forth below several patentable distinctions of the claimed invention over the combination of the JP and Mock patents. First, independent Claim 1 defines a thermometer housing having at least a substantial portion of at least one of an outer surface and an inner surface being rougher than a substantially transparent viewing area surface so that light passing through the rougher surface is diffusely scattered. Independent Claim 17 has been amended to define a thermometer housing including a light diffusing portion having an integrally molded textured surface thereon. The result in both Claims is that the rougher surface is substantially non-transparent and the substantially transparent viewing area surface allows the display element to be visible therethrough. It is respectfully submitted that while the Mock patent discloses an inner spherical surface being roughened, the roughened surface disclosed by Mock does not permit light to be passed therethrough, as defined by Claims 1 and 17 of the present invention.

In particular, Mock discloses an apparatus for measuring high energy laser beam power including a hollow spherical casing for admitting the full intensity of the laser beam therein. (See Abstract.) The spherical casing is a thin-walled copper member adapted to permit rapid transfer of heat energy. (See col. 4, lines 37-39.) While the interior surface of the sphere can be roughened by grit-blasting and also blackened by surface treatment, the purpose of roughening the surface is to assist absorptivity or heat exchange and minimize reflections. (See col. 4, lines 39-43.) In other words, the inner surface of the sphere is not roughened to diffusely scatter light passing therethrough as presently defined in independent Claims 1 and 17. Indeed, the Mock sphere is made of copper, whereby no light can possibly pass through it. As such, the very purpose of the sphere is to contain the laser beams therein without permitting any laser light to escape. Thus, the Mock patent clearly teaches away from the claimed invention. It is improper to combine references where the references teach away from the combination. *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983); *See also* MPEP §2145(X)(D)(2).

Moreover, Mock does not teach one surface being rougher than another surface. The entire inner spherical surface of Mock is grit-blasted or blackened. Thus, Mock does not disclose a substantially transparent viewing surface, whereby a display element positioned within the housing adjacent the viewing surface is visible therethrough, as defined in Claim 1. Nor does Mock teach a light diffusing portion having an integrally molded textured surface formed thereon, as defined in amended Claim 17. As discussed above, the roughened surface disclosed by Mock is achieved by grit-blasting or blackening. There is no mention in Mock of integrally molding a textured surface so that light passing through the surface will be diffusely scattered.

In stark contrast, the thermometer housing of the claimed invention is made from a transparent material so that an interior display element may be visible from outside the housing. Other than a viewing surface adjacent the display element, the housing surface is then roughened so that light passing through the rougher surface is diffusely scattered. In

other words, light may still pass through the transparent housing material at the roughened surfaces, but the light will be scattered making the roughened surface appear opaque as opposed to the viewing surface. This is entirely different than roughening a copper surface for the purpose of absorbing heat and light energy, as disclosed by Mock. Therefore, it is respectfully submitted that Claims 1 and 17, and the Claims that depend therefrom patentably distinguish over the prior art.

Second, as mentioned above, the Mock patent is directed to an apparatus for measuring high energy laser beam power. Such a device is entirely unrelated to a digital fever thermometer as disclosed in the JP reference and, therefore, there is no incentive to combine the teachings disclosed by Mock with the thermometer disclosed by the JP reference.

It is well settled that "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned." *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). The Mock patent relates to a high energy laser beam measurement apparatus. Thus, it is highly unlikely that the Mock patent "would have commended itself to an inventor's attention in considering his problem" with respect to diffusing light through a transparent digital thermometer housing, as endeavored by the claimed invention. *See In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). Accordingly, it is respectfully submitted that the Mock patent is nonanalogous art which cannot be relied upon in determining obviousness under 35 U.S.C. §103 of the subject matter at issue.

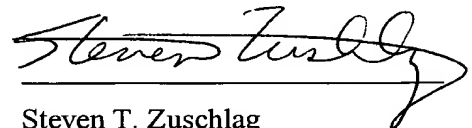
Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Additionally, when applying 35 U.S.C. §103, the references must suggest the desirability and thus the

obviousness of making the combination without the benefit of impermissible hindsight vision afforded by the claimed invention. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986). Thus, it is improper hindsight merely to "pick and choose" components from the prior art references to arrive at the claimed invention. There must be a suggestion in the prior art references to combine the components as recited in the claimed invention. See MPEP §2141 - §2143. It is respectfully submitted that there is no suggestion in the prior art references for combining a roughened copper surface, as disclosed by Mock, with a transparent thermometer housing, as disclosed by the JP reference. Therefore, contrary to the Examiner's assertion, it would not have been obvious to one skilled in the art to combine the references.

In view of the foregoing amendments and remarks, entry and favorable consideration of the amendment and allowance of the application with Claims 1-10 and 17 are respectfully solicited.

If the Examiner believes that a telephone interview would assist in moving the application toward allowance, she is respectfully invited to contact the Applicant's attorney at the telephone number listed below.

Respectfully submitted,



Steven T. Zuschlag
Registration No.: 43,309
Attorney for Applicant(s)

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(516) 822-3550
STZ:mf
149645_1

VERSION OF AMENDMENT WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please amend Claims 3, 9 and 17 as follows:

3, (Twice Amended) An electronic fever thermometer according to Claim 1, wherein the thermometer further includes a ~~main part and~~ a cover part secured to the housing, the cover part being ~~which are each~~ produced in one piece from a transparent plastic material.

9. (Twice Amended) An electronic fever thermometer according to Claim 3 ~~1~~, wherein the cover part ~~thermometer~~ is sealed to the housing by ultrasonic welding.

17. (Amended) An electronic fever thermometer comprising:
a temperature sensor;
a display element for displaying the temperature measured by the temperature sensor; and

a housing made from a transparent material for housing the temperature sensor and the display element, wherein the housing includes a substantially transparent viewing portion surface and a substantially non-transparent light diffusing portion surface, the light diffusing portion having an integrally molded textured surface formed thereon, whereby the light diffusing portion is ~~surface being~~ rougher in texture than the viewing portion surface so that light passing through the light diffusing portion surface is diffusely scattered, the display element being positioned within the housing adjacent the viewing portion surface to be visible therethrough.